

Attorney Docket No.: ISPH-0617
Inventors: Bennett et al.
Serial No.: 10/001,844
Filing Date: November 16, 2001
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REMARKS

Claims 1, 2 and 4-15 are pending in the instant application. Claims 1, 2, 12 and 14 have been rejected. Claims 4-10, 13 and 15 have been objected to. Claims 2 and 4 have been canceled. Claims 1, 5, 6, 8 and 10 have been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Objection to the Claims

Claims 4-10, 13 and 15 have been objected to as being dependent upon a rejected base claim but the Examiner suggests they would be allowable if rewritten in independent form including all the limitations of the base claims and any intervening claims. Applicants have amended claim 1 to incorporate the limitations of claim 4. Withdrawal of this objection is respectfully requested.

II. Rejection of Claims Under 35 U.S.C. 102/103

Claims 1, 2, 12 and 14 have been rejected under 35 U.S.C. 102(b) or 103(a) as being anticipated by or obvious over Palm (2000). The Examiner suggests that this reference teaches a primer that possesses 100% identity with residues 756 through 782 of SEQ

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ID NO: 3 and without evidence to the contrary would specifically hybridize with the claimed target region. Applicants respectfully traverse this rejection.

Applicants have amended the claims to refer to antisense compounds that comprise at least one modified internucleoside linkage. Support for this amendment can be found throughout the specification as filed.

Palm et al. (2000) disclose a single primer for SHH that is reverse complementary to 756 through 781 of SEQ ID NO: 3. No antisense compounds of any type capable of inhibiting expression of SHH, including any with modifications as claimed, are taught or suggested by this reference. It is only with the specification in hand that one of skill would understand that the compounds as claimed would have the ability to inhibit expression of SHH. In order to anticipate or make obvious a claim the cited reference must teach each and every limitation of the claim (MPEP 2131 and 2143). This reference fails to teach the limitations of the claims as amended and thus cannot anticipate or make obvious the instant invention. Withdrawal of this rejection is respectfully requested.

Claims 1, 2, 12 and 14 have been rejected under 35 U.S.C. 102(e) and 103(a) as being anticipated by or obvious over Altaba et

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al. (US Patent 6,238,876). The Examiner suggests that this patent discloses a single sequence (SEQ ID NO: 6) that possesses 100% identity with residues 560 through 577 of SEQ ID NO: 3 of the instant application and that absent evidence to the contrary this compound would inhibit expression of SEQ ID NO: 3 as claimed. Applicants respectfully traverse this rejection.

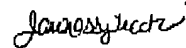
As discussed *supra*, Applicants have amended the claims to refer to modified antisense compounds. Altaba et al. disclose a single sequence that is reverse complementary to residues 559 through 572 of SEQ ID NO: 3 of the instant application. Nowhere does this patent teach or suggest antisense compounds as claimed that are capable of inhibiting expression of SEQ ID NO: 3, including compounds modified as now claimed. In order to anticipate or make obvious a claim the cited reference must teach each and every limitation of the claim (MPEP 2131 and 2143). This reference fails to teach the limitations of the claims as amended and thus cannot anticipate or make obvious the instant invention. Withdrawal of this rejection is respectfully requested.

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III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



Jane Massey Licata
Registration No. 32,257

Date: September 14, 2004

Licata & Tyrrell P.C.
66 E. Main Street
Marlton, NJ 08053

856-810-1515